

Appl. No. : 09/993,874
Filed : November 14, 2001

Claim Rejections – 35 U.S.C. § 112, First Paragraph

The Examiner has maintained her rejection of Claims 1, 7, and 8 as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention when the application was filed. This 35 U.S.C. § 112, paragraph 1, written description rejection centers on the claim limitation “a maximum λ of approximately 549 nm.” The Examiner has stated that “[w]hile there is support in the specification for ‘a maximum $\lambda = 549 \text{ nm}$ ’ . . . [she] is unable to locate adequate support in the specification for the word ‘approximately’ in that phrase.” (the paragraph bridging pages 4 and 5 in the Office Action of May 14, 2004)

Applicant respectfully submits that, in focusing too narrowly on the text of the originally-filed specification and specifically on the absence of the words “a maximum λ of approximately 549 nm” in that specification, the Examiner overlooks the clear support for the claim limitation present in originally-filed Figure 3. It is well-settled that an applicant for a patent may provide written description support for claim limitations by means of, among other things, “figures [and] diagrams.” Lockwood v. Am. Airlines, Inc., 107 F.3d 1565, 1572 (Fed. Cir. 1997); M.P.E.P. § 2163(I) (citing Lockwood). It is not necessary that a claim limitation appear word for word in the text of the patent specification. Id. (“[T]he exact terms need not be used *in haec verba*.”). Rather, “drawings alone may provide a ‘written description’ of an invention as required by § 112.” Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1565 (Fed. Cir. 1991); see also Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc., 291 F.3d 1317, 1322 (Fed. Cir. 2002) (“Drawings constitute an adequate description if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed.”); M.P.E.P. § 2163(II)(A)(3)(a) (noting that possession of an invention may be shown by “disclosure of drawings,” and citing Vas-Cath).

Applicant submits that Figure 3, which was submitted with the originally-filed application and which shows the bioluminescence spectrum of the luciferase encoded by the claimed nucleic acid sequence, provides written description support for the term “approximately” in the limitation at issue. The spectrum shown in Figure 3 (the Figure is attached for the convenience of the Examiner) does not exhibit a sharp peak at 549 nm. Rather, it shows a broad peak centered just to the left of the 550 nm mark. The originally-filed specification describes this spectrum as “centered at 549 nm.” Specification at p. 5, l. 18; p. 36, l. 3. Applicant submits that